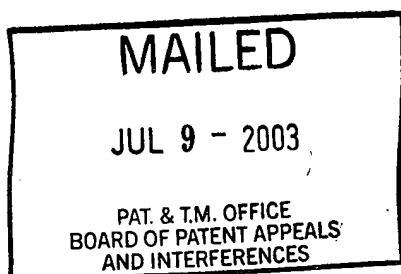




## UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES  
BOX INTERFERENCE, WASHINGTON, D.C. 20231

Filed by: Judge Jameson Lee  
Telephone: (703) 308-9797  
Facsimile: (703) 305-0942



Applicant: PRASAD  
Application No.: 09/265,625  
Filed: 03/10/99  
For: TWO-PHOTON UPCONVERTING DYES AND  
APPLICATIONS  
Accorded benefit: Application 08/712,143, filed  
09/05/96, now Patent 5,912,257, granted 06/15/99;  
Provisional 60/010330, filed 12/15/95

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,133.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

A handwritten signature in cursive script, reading "Jameson Lee", written over a horizontal line.  
JAMESON LEE  
Administrative Patent Judge

**INTERFERENCE DIGEST**

Interference No. 105,133

Paper No. 20

Name: Paras N. Prasad et al.

Serial No.: 09/265,625

Patent No.

Title: TWO-POTON UPCONVERTING DYES AND APPLICATIONS

Filed: 03/10/99

Interference with Fisher et al.

**DECISION ON MOTIONS**

Administrative Patent Judge, \_\_\_\_\_ Dated, \_\_\_\_\_

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

**FINAL DECISION**

Board of Patent Appeals and Interferences, Adverse Dated, 1-13-04

\_\_\_\_\_  
Court, \_\_\_\_\_ Dated, \_\_\_\_\_

**REMARKS**

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

This should be placed in each application or patent involved in interference in addition to the interference letters.

Filed by: Jameson Lee  
Administrative Patent Judge  
Mail Stop Interference  
Board of Patent Appeals and Interferences  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
Tel: 703-308-9797  
Fax: 703-305-0942

Filed:  
9 July 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

WALTER G. FISHER, ERIC A WACHTER  
and H. CRAIG DEES,

Junior Party,  
(Patent 5,829,448),

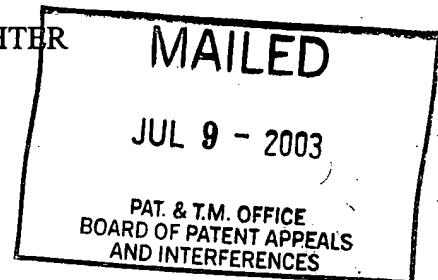
v.

PARAS N. PRASAD, JAYANT D. BHAWALKAR,  
GUANG S. HE, CHAN F. ZHAO  
and JAROSLAW ZIEBA,

Senior Party,  
(Application 09/265,625).

Patent Interference No. 105,133

NOTICE DECLARING INTERFERENCE  
(37 CFR § 1.611)



**Part A. Declaration of interference**

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties. Details of the application(s), patent (if any), reissue application (if any), count(s) and claims designated as corresponding or as not corresponding to the count(s) appear in Parts E and F of this NOTICE DECLARING INTERFERENCE.

**Part B. Judge designated to handle the interference**

Administrative Patent Judge Jameson Lee has been designated to handle the interference. 37 CFR § 1.610(a).

**Part C. Standing order**

A Trial Section STANDING ORDER accompanies this NOTICE DECLARING INTERFERENCE. The STANDING ORDER applies to this interference.

**Part D. Conference call to set dates**

A telephone conference call to set dates for taking action in the interference is scheduled for 2:00 p.m. on 26 August 2003 (the call will be initiated from the PTO).

No later than two business days prior to the conference call, each party shall file and serve by facsimile a list of the preliminary motions the party intends to file. See STANDING ORDER ¶ 10.

A copy of a "sample" order setting times for taking action during the preliminary motion phase of the interference accompanies this NOTICE DECLARING INTERFERENCE. Counsel are encouraged to discuss the order prior to the conference call with the view to coming to some agreement as to dates for taking action. A typical preliminary motion period lasts approximately nine (9) months. Counsel should be prepared to justify any request for a shorter or longer period.

**Part E. The parties involved in this interference are:**

Junior Party

Named inventors: WALTER G. FISHER, Knoxville, TN  
ERIC A. WACHTER, Oak Ridge, TN  
H. CRAIG DEES, Knoxville, TN

Patent: 5,829,448, granted 3 November 1998,  
based on Application 08/739,801,  
filed 30 October 1996

Title: Method for improved selectivity in photo-  
activation of molecular agents

Assignee: Photogen, LLC

Accorded Benefit: None

Attorneys: See last page

Address: See last page

Senior Party

Named Inventors: PARAS N. PRASAD, Williamsville, N.Y.  
JAYANT D. BHAWALKAR, Tonawanda, N.Y.  
GUANG S. HE, Williamsville, N.Y.  
CHAN F. ZHAO, San Diego, CA  
JAROSLAW ZIEBA, Santa Rosa, CA

Application: 09/265,625, filed 10 March 1999

Title: Two-photon upconverting dyes and applications

Assignee: None

Accorded Benefit: 5,912,257, granted 15 June 1999, based on  
application 08/712,143, filed 5 September 1996  
Provisional 60/010,330, filed 15 December 1995

Attorneys: See last page

Address: See last page

**Part F. Counts and claims of the parties**

Count 1

Claims 290, 299 or 313 of Prasad's application 09/265,625

or

Claims 1, 10 or 40 of Fisher's Patent 5,829,448

The claims of the parties are:

Fisher: Claims 1-68

Prasad: Claims 290-325

The claims of the parties which correspond to **Count 1** are:

Fisher: Claims 1-19, 21, 23, 40-45, 50-51

Prasad: Claims 290-310, 313-320

The claims of the parties which do not correspond to **Count 1** are:

Fisher: Claims 20, 22, 24-39, 46-49, 52-68

Prasad: Claims 311, 312, 321-325

**Part G. Heading to be used on papers**

The following heading shall be used on papers filed in the interference. See STANDING ORDER ¶ 3.5.

Paper \_\_\_\_<sup>1</sup>

Filed on behalf of [name of party]

By: Name of lead counsel, Esq.  
Name of backup counsel, Esq.  
Street address  
City, State, and Zip-Code  
Tel:  
Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
(Administrative Patent Judge Jameson Lee)

WALTER G. FISHER, ERIC A WACHTER  
and H. CRAIG DEES,  
**Junior Party,**  
(Patent 5,829,448),

v.

PARAS N. PRASAD, JAYANT D. BHAWALKAR,  
GUANG S. HE, CHAN F. ZHAO  
and JAROSLAW ZIEBA,  
**Senior Party,**  
(Application 09/265,625).

Patent Interference No. 105,133

TITLE OF PAPER

<sup>1</sup> Leave a blank line because the board assigns the paper number.



## **Part H. Summary of dates for taking action**

Times for taking action are set out in the following sections of the STANDING ORDER:

- ¶ 4: date for identifying lead and backup counsel.
- ¶ 5: date for identifying any real party in interest.
- ¶ 6: date for requesting copies of involved and benefit applications and patents.
- ¶ 7: date for accomplishing certain discovery.
- ¶ 8: date for filing clean copy of claims.
- ¶ 9: date for filing clean copy of claims in cases with drawings or claims containing a means plus function limitation.
- ¶ 10: date for filing list of proposed preliminary motions.
- ¶ 13.10.2: dates for filing oppositions to Rule 635 miscellaneous motions and dates for filing replies to oppositions.
- ¶ 14.1.1: date for objecting to admissibility of evidence.
- ¶ 14.2: date for serving supplemental affidavits or evidence to respond to objection to admissibility of evidence.
- ¶ 14.3: dates when cross-examination can take place.
- ¶ 15.2: dates for taking action with respect to settlement discussions.

**Part I. Order form for requesting file copies**

**FILE COPY REQUEST**

**Interference 105,133**

A copy of Part E of this NOTICE DECLARING INTERFERENCE should be attached to this FILE COPY REQUEST, with a circle by hand around the patents and applications for which a copy of a file wrapper is desired.

To facilitate processing of this FILE COPY REQUEST, the following information should be included:

1. Charge fees to USPTO Deposit Account No. \_\_\_\_\_
2. Complete address, including street, city, state, zip code and telephone number (do not list a Post Office box inasmuch as file copies are sent via commercial overnight courier).

---

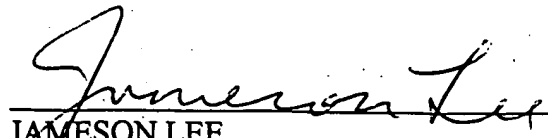
---

---

---

Telephone, including area code: \_\_\_\_\_

**Part J. Signature of administrative patent judge**

  
JAMESON LEE  
Administrative Patent Judge

Date: 7/9/03  
Arlington, VA

Enc:

Standing Order

PTO-850

Copy of order used for setting times for taking action in the preliminary motion phase of the interference

Copy of order used for setting times for taking action in the testimony and briefing phases of the interference

Copy U.S. Patent 5,829,448

Copy of claims of 09/265,625

Revised May 2003

cc (via Federal Express):

Attorney for FISHER:

Mark J. Murphy, Esq.  
COOK, ALEX, McFARRON, MANZO, CUMMINGS  
& MEHLER, LTD  
200 West Adams Street, Suite 2850  
Chicago, IL 60606

Attorney for PRASAD:

Michael L. Goldman, Esq.  
NIXON PEABODY LLP  
Clinton Square  
Rochester, N.Y. 14604